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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,928	10/21/2003	Masafumi Yamanoue	0033-0906P	3179
2292	7590	05/04/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			AIRAPETIAN, MILA	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/688,928

Applicant(s)

YAMANOUE ET AL.

Examiner

Mila Airapetian

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09/14/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Amendment received on 2/16/2006 is acknowledged and entered. Claims 9 and 11-26 have been canceled. Claim 8 has been amended. Claims 1-8 and 10 are currently pending in the application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 8 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Berstis et al. (hereinafter Berstis) (US 6,282,653).

Claim 1.

Berstis teaches royalty collection system for use of copyrighted digital materials on the internet comprising:

a manipulation unit for selection of a desired electronic copyrighted work (col. 11, lines 37-62);

a copyright royalty information storage unit storing copyright royalty information of an electronic copyrighted work (col. 8, lines 8-10, lines 21-26);

a copyrighted work data storage unit storing electronic copyrighted work data (col. 6, lines 36-42),

a copyright royalty calculation unit calculating a copyright royalty of an electronic copyrighted work selected through said manipulation unit based on the copyright royalty information stored in said copyright royalty information storage unit (col. 5, lines 51-63, lines 36-49);

a communication unit transmitting to an external source the copyright royalty calculated by said copyright royalty calculation unit (col. 8, lines 8-17); and

a copyrighted work data write unit writing into a recording medium electronic copyrighted work data corresponding to the electronic copyrighted work selected through said manipulation unit out from electronic copyrighted work data stored in said copyrighted work data storage unit (col. 5, lines 19-21, lines 25-26).

Claim 2. Berstis further teaches said system, further comprising a sales information recording unit recording sales status of a relevant electronic copyrighted work sales apparatus (col. 9, lines 50-53).

Claim 8. Berstis teaches royalty collection system for use of copyrighted digital materials on the Internet, comprising:

a communication unit receiving from an external source copyright royalty data of an electronic copyrighted work sold (col. 7, lines 3-12);

a copyright information storage unit storing copyright information of an electronic

copyrighted work to be sold (col. 6, lines 36-42); and

a copyright royalty data storage unit storing for each copyright holder copyright royalty data received by said communication unit according to the copyright information stored in said copyright information storage unit (col. 8, lines 8-10, lines 21-26); and

a copyright royalty data approval processing unit causing said communication unit to transmit to an external source copyright royalty data recorded in said copyright royalty data recording unit when copyright royalty data stored in said copyright royalty data storage unit is approved (*"control routine remainder of the account is then distributed to the content provider;"* col. 8, lines 21-28).

Claim 10. Berstis further teaches a system comprising:

an electronic copyrighted work sales apparatus selling an electronic copyrighted work (col. 2, lines 37-46, lines 63-67);

a copyright management apparatus (central authority) administering a copyright royalty of an electronic copyrighted work sold by said electronic copyrighted work sales apparatus (col. 10, lines 2-7);

a seller terminal used by a seller (col. 7, lines 1-3); and

a copyright holder terminal used by a copyright holder (col. 8, lines 14-25; indicates a holder terminal for transmitting copyrighted files to the seller (source) terminal), wherein said electronic copyrighted work sales apparatus includes a manipulation unit for selection of a desired electronic copyrighted work (col. 11, lines 37-62);

a copyright royalty information storage unit storing copyright royalty information of an electronic copyrighted work (col. 8, lines 15-28),

a copyrighted work data storage unit storing electronic copyrighted work data (col. 7, line 3);

a copyright royalty calculation unit calculating a copyright royalty of an electronic copyrighted work selected through said manipulation unit according to the copyright royalty information stored in said copyright royalty information storage unit (col. 5, lines 36-49, 51-63),

a first communication unit transmitting to said copyright management apparatus (central authority) the copyright royalty calculated by said copyright royalty calculation unit (col. 10, lines 2-7; means for notifying the central authority), and

a copyrighted work data write unit writing into a recording medium electronic copyrighted work data corresponding to the electronic copyrighted work selected through said manipulation unit out from electronic copyrighted work data stored in said copyrighted work data storage unit (col. 5, lines 19-21; lines 25-26);

wherein said copyright management apparatus includes a second communication unit receiving from said copyrighted work sales apparatus copyright royalty data of an electronic copyrighted work sold (col. 10, lines 2-7; notifying the central authority indicates providing communication means for the central authority);

a copyright information storage unit storing copyright information of an electronic copyrighted work to be sold (col. 6, lines 36-42);

a copyright royalty data storage unit storing for each copyright holder copyright

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royalty data received by said second communication unit according to the copyright information stored in said copyright information storage unit (col. 8, lines 8-10, lines 21-26); and

a copyright royalty data approval processing unit causing said second communication unit to transmit copyright royalty data recorded in said copyright royalty data storage unit to said seller terminal when the copyright royalty data stored in said copyright royalty data storage unit is approved from said copyright terminal (col. 9, lines 21-26).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berstis in view of Official notice.

Claim 7. Berstis further teaches said system further comprising a recording media storage unit (col. 5, lines 19-21, lines 25-26).

Berstis teaches that said digital files can be stored on a hard drive. Berstis does not specifically teach that said hard drive comprises a plurality of recording media.

Official Notice is taken that it is old and well known that hard drives are partitioned into a plurality of independent segments for storing different files. Therefore, it would have been obvious to one having ordinary skills in the art at the time the invention was made to modify Berstis to include that hard drives comprises a plurality of segments because dividing the hard drive into multiple partitions would improve performance and simplify backups (See, for example, US 6,202,070 to Nguyen et al.; col. 1, lines 42-44; col. 24, lines 13-43).

Claims 3-6 are rejected under 35 U.S.C. 102(e) as being unpatentable over Berstis in view of Schelberg et al. (US 2004/0190694).

Claim 3. Berstis further teaches said apparatus further comprising an identification information storage unit storing identification information of an electronic copyrighted work sales apparatus (col. 3, lines 65-66).

However Berstis does not teach a sales information control unit sensing attachment of a sales information *readout card* corresponding to the identification information stored in said identification information storage unit, and reading out sales status recorded in said sales information recording unit.

Schelberg et al. (Schelberg) teaches a vending machine for dispensing telecommunications access wherein the payment processing unit accept payment by smart card (0052).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Berstis to include using a *smart card* for identification and transaction purposes, as disclosed in Schelberg, because it would advantageously allow to employ a well known and secure financial mechanism for effecting said transactions, thereby providing convenience to the customer.

Claim 4. Berstis further teaches said apparatus wherein said sales information control unit reads out the sales status recorded in said sales information recording unit by reading out and executing a portion of a program corresponding to the identification information stored in said identification information storage unit (col. 9, lines 24-45). Schelberg discloses the use of smart card for paying for dispensing of telecommunications access (0052). The motivation to combine the references would be to employ a well known and secure financial mechanism for effecting said transactions, thereby providing convenience to the customer.

Claim 5. Berstis further teaches said apparatus further comprising an identification information storage unit storing identification information of an electronic copyrighted work sales apparatus (col. 3, lines 65-66).

However Berstis does not teach a sales information control unit sensing attachment of a sales information *management card* corresponding to the identification information stored in said identification information storage unit, and reading out sales status recorded in said sales information recording unit.

Schelberg et al. (Schelberg) teaches a vending machine for dispensing telecommunications access wherein the payment processing unit accept payment by smart card (0052).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Berstis to include using a *smart card* for identification and transaction purposes, as disclosed in Schelberg, because it would advantageously allow to employ a well known and secure financial mechanism for effecting said transactions, thereby providing convenience to the customer.

Claim 6. Berstis further teaches said apparatus wherein said sales information control unit reads out the sales status recorded in said sales information recording unit by reading out and executing a portion of a program corresponding to the identification information stored in said identification information storage unit (col. 9, lines 24-45). Schelberg discloses the use of smart card for paying for dispensing of telecommunications access (0052). The motivation to combine the references would be to employ a well known and secure financial mechanism for effecting said transactions, thereby providing convenience to the customer.

Response to Arguments

Applicant's arguments filed 2/16/2006 have been fully considered but they are not persuasive.

In response to applicant's argument that Berstis fails to teach "*a manipulation unit for selection of a desired electronic copyrighted work*", it is noted that Berstis explicitly teaches said feature, Specifically, Berstis teaches (col. 11, lines 37-62).

A pointing device 147, which is preferably a trackpoint or "button" pointing device, is included on remote control unit 106 and allows a user to manipulate a cursor on the display of television 104. "Go" and "Back" buttons 148 and 150, respectively, allow a user to select an option or return to a previous selection. "Help" button 151 causes context-sensitive help to be displayed or otherwise provided. "Menu" button 152 causes a context-sensitive menu of options to be displayed, and "Update" button 153 will update the options displayed based on the user's input, while home button 154 allows the user to return to a default display of options. "PgUp" and "PgDn" buttons 156 and 158 allows the user to change the context of the display in display-sized blocks rather than by scrolling. The message button 160 allows the user to retrieve messages.

In addition to, or in lieu of, remote control unit 106, an infrared keyboard (not shown) with an integral pointing device may be used to control data processing unit 102. The integral pointing device is preferably a trackpoint or button type of pointing device. A wired keyboard (also not shown) may also be used through keyboard connection 120, and a wired pointing device such as a mouse or trackball may be used through mouse port 122. When a user has one or more of the remote control unit 106, infrared keyboard, wired keyboard and/or wired pointing device operable, the active device locks out all others until a prescribed period of inactivity has passed.

In response to applicant's argument that Berstis fails to teach "*a manipulation unit that will perform selection*" it is noted that said feature upon which applicant relies in claim 1 is not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that the prior art fails to anticipate features recited in Claims 5 and 7, Examiner points out that said Claims stand rejected under 35 USC § 103. Claim 5 is rejected as being unpatentable over Berstis et al. in view of Schelberg et al.; and Claim 7 is rejected as being unpatentable over Berstis et al. in view of Official notice.

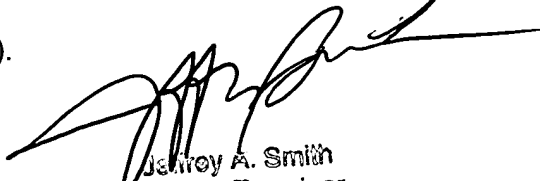
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mila Airapetian whose telephone number is (571) 272-3202. The examiner can normally be reached on Monday-Friday 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA



Jeffrey A. Smith
Primary Examiner